

REMARKS/ARGUMENTS

Claims 54-64 are pending. By this Amendment, claim 57 is amended. Support for the amendments to claim 57 can be found, for example, in original claim 57. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Double Patenting

The Office Action provisionally rejects claims 54-57 under the judicially created doctrine of obviousness-type double patenting over claims 54-61 of U.S. Patent Application No. 10/622,486. Applicant submits that the Terminal Disclaimer filed herewith obviates the rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §103(a)

A. Porter and Crotty

The Office Action rejects claims 54-57 under 35 U.S.C. §103(a) over U.S. Patent No. 5,968,533 to Porter et al. ("Porter") in view of U.S. Patent No. 6,174,536 to Crotty et al. ("Crotty"). Applicant respectfully traverses the rejection.

Claims 54 recites "[a] test kit for visualizing skin lines and skin wrinkles, comprising: (i) a transparent substrate having an adhesive surface, wherein the adhesive is capable of making an image of skin lines and wrinkles after removal of the substrate from the skin; (ii) a visualizing substrate having a darkened area which is capable of receiving the substrate after removal from the skin; and (iii) a plurality of reference images adapted to provide a comparison with the image formed on the adhesive surface of the substrate" (emphasis added). Porter and Crotty do not disclose or suggest such a kit.

Porter discloses a dermal delivery device, including an adhesive strip, for treatment of skin wrinkles. *See, e.g., Porter*, column 12, lines 45 to 48. Crotty discloses a numeric formula, in which the number of keratotic plugs removed by an adhesive strip are counted, for evaluating the efficacy of a product. *See, e.g., Crotty*, column 5, lines 1 to 37. However, neither Porter nor Crotty discloses a kit including the features of claim 54.

For example, the kit of claim 54 requires a plurality of reference images. Neither Porter nor Crotty discloses a kit including a plurality of reference images. Also, the kit of claim 54 includes a transparent substrate, which makes it possible to visualize the substrate both when on the skin and when placed against the darkened area of the visualizing substrate. Neither Porter nor Crotty includes such a transparent substrate. Moreover, neither Porter nor Crotty discloses a visualizing substrate including a darkened area, as in the kit of claim 54.

As Porter and Crotty fail to disclose or suggest a kit including a transparent substrate, a visualizing substrate having a darkened area and plurality of reference images, the combination of reference fails to disclose or suggest each and every feature of claim 54.

As explained, claim 54 would not have been rendered obvious by Porter and Crotty. Claims 55-57 depend from claim 54 and, thus, also would not have been rendered obvious by Porter and Crotty. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Porter, Bae and Crotty II

The Office Action rejects claims 58-64 under 35 U.S.C. §103(a) over Porter in view of U.S. Patent No. 5,723,138 to Bae et al. ("Bae"), FR 2.063.743 to Bouyer ("Bouyer")\* and U.S. Patent No. 5,935,596 to Crotty et al. ("Crotty II"). Applicant respectfully traverses the rejection.

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\* Discussion of Bouyer is made with reference to the English-language translation made of record in this application.

Claim 58 recites "[a] method for evaluating the efficacy of a skin treatment product, comprising: applying a first transparent substrate having an adhesive surface to the skin, wherein the adhesive makes an image of skin lines and wrinkles after removal of the first transparent substrate from the skin; removing the transparent substrate from the skin and placing the transparent substrate on a visualizing substrate having a darkened area; applying a skin treatment product to the skin; applying a second transparent substrate having an adhesive surface to the skin, wherein the adhesive makes an image of skin lines and wrinkles after removal of the second transparent substrate from the skin; removing the transparent substrate from the skin and placing the second transparent substrate on a visualizing substrate having a darkened area; and comparing the image from the first transparent substrate and the image from the second transparent substrate" (emphasis added). Porter, Bae, Bouyer and Crotty II do not disclose or suggest such a method.

As is evident from the above-quoted claim language, the method of claim 58 is method for evaluating skin, e.g., to determine whether a cosmetic treatment has been effective. *See, e.g.*, present specification, paragraphs [0016] and [0017]. That is, the purpose of the method is not to treat, but to evaluate.

Porter, Bae and Crotty II disclose methods in which a cosmetic treatment is administered to the skin via an adhesive provided on an impermeable backing, laminate or strip. *See, e.g.*, Porter, column 4, lines 28 to 40; Bae, Abstract; Crotty II, Abstract. In each of these references, a substrate including an adhesive including a cosmetic agent is applied to the skin to treat the skin, not to determine the efficacy of a cosmetic treatment. There is no evaluation of the substrates of these references, as required by the method of claim 58.

Bouyer discloses a method in which an adhesive strip is applied to the skin and then lifted off to carry away surface elements of the epidermis, to provide a sampling of the skin surface. *See, e.g.*, Bouyer, page 1, lines 10 to 14. Bouyer does not disclose applying a skin

treatment product to the skin after removing a first transparent substrate from the skin. In addition Bouyer does not disclose applying and removing a second transparent substrate to undertake a comparison of the first transparent substrate (taken before the skin treatment) and the second transparent substrate (taken after the skin treatment).

That is, while Bouyer may disclose evaluating skin before treatment, Bouyer does not remotely disclose or suggest conducting a comparative analysis before and after skin treatment to determine the efficacy of that treatment. The only teaching or suggestion to do so is found in the present specification. None of the cited references discloses or suggests each of the steps recited in the method of claim 58.

As explained, claim 58 would not have been rendered obvious by Porter, Bae, Bouyer and Crotty II. Claims 59-64 depend from claim 58 and, thus, also would not have been rendered obvious by Porter, Bae, Bouyer and Crotty II. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

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Conclusion

For the foregoing reasons, Applicant submits that claims 54-64 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

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Attachment: Terminal Disclaimer